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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of) BEFORE THE BOARD OF PATENT
Katsuhiko AOKI et al.) APPEALS AND INTERFERENCES
Serial No. 09/112,020) Appeal No.:
Filed: July 8, 1998) Examiner: Edward F. Urban
For: MOBILE COMMUNICATION) Group Art Unit: 2683
TERMINAL EQUIPMENT USABLE) January 2, 2001
FOR BOTH SATELLITE AND)
TERRESTRIAL COMMUNICATIONS)

REPLY BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is a reply to the Examiner's Answer dated November 2, 2000.

At page 7, the Examiner admits that "the claims do not specifically recite that the satellite transceiver be portable," but cites the fact that the claims "do encompass such an embodiment" (emphasis added) to support the rejection based on the written description requirement of 35 U.S.C. § 112. The written description requirement precludes the presentation of claims directed to subject matter not sufficiently described in the specification so as to reasonably convey to one skilled in the art that the inventor was in possession of the claimed

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invention at the time the application was filed. The Answer makes clear that rather than examining the claims for compliance with the written description requirement under the established standard, the Examiner has sought to determine whether the claims could be construed to encompass subject matter not explicitly described in the original application.

To reiterate, the written description analysis does not involve a determination, as made in the final rejection, of whether the claims may be interpreted to encompass an embodiment not explicitly described in the specification. The Examiner acknowledges at page 9 of the Answer that later added claims need not be limited to the specifics of the disclosed embodiments in order to satisfy the written description requirement under 35 U.S.C. § 112. However, that is precisely what the Examiner is requiring in rejecting claims 19-26 under the first paragraph of 35 U.S.C. § 112. As is apparent from the comments at page 7 of the Answer, the Examiner would require all of the claims to contain the limitation of a vehicle to transport the satellite transceiver, simply because the disclosed embodiments involve the use of a vehicle. Under the Examiner's analysis, claims never could be added to an application unless they included the entire structure of the disclosed embodiments. Such an analysis is contrary to the established case law and is improper.

Regarding the 35 U.S.C. § 103 rejection, the Answer at page 9 alleges that the '534 reference "teaches" that separate transceivers could be interchanged, thereby allowing increased flexibility. According to the Examiner, this "teaching" would have suggested that the input/output circuit and switching means can be placed on the terrestrial side of the equipment. Contrary to the Examiner's assertion, the portion of the '534 reference relied upon for this "teaching" is simply an introductory paragraph for the description of the system of Fig. 5, which has been explained in detail in Appellants' main brief (see Brief at pp. 9-10). In Fig. 5, the switch for switching between the terrestrial and satellite system is provided on the satellite side.

Finally, it is noted that in response to Appellants' argument regarding the nonobviousness of modifying the Wiedeman system as proposed by the final rejection, the Examiner relies on the title of the Wiedeman patent and on an unsupported conclusory assertion as to what one of ordinary skill would want to do in purported support of the rejection. Such conjecture hardly forms a proper foundation for a rejection under 35 U.S.C. § 103.

CONCLUSION

In view of the foregoing and the arguments in the main brief on appeal, claims 19-26 are submitted to be directed to a new and unobvious mobile communication terminal for satellite and

terrestrial wireless communications, which is not taught by the prior art, and which is fully supported by the original specification as filed. The Honorable Board is respectfully requested to reverse all grounds of rejection and to direct the passage of this application to issue.

Please charge any fee or credit any overpayment pursuant to 37 CFR 1.16 or 1.17 to Deposit Account No. 02-2135.

Respectfully submitted,

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